



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/047,726 | 01/15/2002 | Alok Nigam | HO-P01709US6 | 7577 |

26271 7590 11/19/2002
FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

PHAN, HIEU

ART UNIT PAPER NUMBER

3738

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,726

Applicant(s)

NIGAM, ALOK

Examiner

Hieu Phan

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3, 5 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Feingold (U.S. Patent 5,913,898).

Feingold teaches a generally circular shaped lens 10 comprising a lens portion 14 with a thickness T_c of and the lens body portion 12 with an edge thickness T_e as is claimed(figures 1-24, column 4 lines 24-67 and column 5 lines 1-64).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feingold (U.S. Patent 5,913,898) in view of Wichterle (U.S. Patent 4,971,732).

Feingold is explained as before. Feingold further lack the body formed of a hydrogel with an index of refraction in the range of 1.36 to 1.39.

Wichterle teaches lens constructed with a hydrogel with a refractive index of 1.37 to 1.45 (Abstract, and column 3 lines 31-63). The motivations for using the material disclosed by Wichterle are the material provides high permeability to oxygen and carbon dioxide and with an index of refraction of 1.37-1.45 the lens project a clear and sharp image to the retina.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of Wichterle to modify the apparatus Feingold to have the body formed of a material with an index of refraction in the range of 1.36 to 1.39. The motivations for incorporating the feature of Wichterle into the apparatus of Feingold are the material provides a high permeability to oxygen and carbon dioxide and with an index of refraction of 1.36-1.45 the lens project a clear and sharp image to the retina.

5. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choyce (U.S. Patent 4,655,774).

Choyce teaches a method of implanting a corneal implant by cutting away portion of the cornea, implanting the corneal implant and replacing the portion of the cornea that was cut away (figures 1-7 and column 2 lines 14-68). But Choyce further lacking the body formed of a hydrogel with an index of refraction in the range of 1.36 to 1.39.

Wichterle teaches lens constructed with a hydrogel with a refractive index of 1.37 to 1.45 (Abstract, and column 3 lines 31-63). The motivations for using the material disclosed by

Art Unit: 3738

Wichterle are the material provides high permeability to oxygen and carbon dioxide and with an index of refraction of 1.37-1.45 the lens project a clear and sharp image to the retina.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of Wichterle to modify the apparatus Choyce to have the body formed of a material with an index of refraction in the range of 1.36 to 1.39. The motivations for incorporating the feature of Wichterle into the apparatus of Choyce are the material provides a high permeability to oxygen and carbon dioxide and with an index of refraction of 1.36-1.45 the lens project a clear and sharp image to the retina.

Conclusion

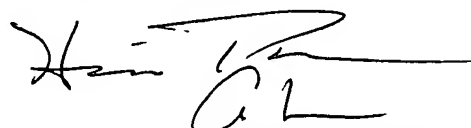
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Phan whose telephone number is 703-308-8969. The examiner can normally be reached on Monday-Friday from 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

Hieu Phan
Examiner
Art Unit 3738

November 17, 2002



CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700